

USSN: 09/872,704

Docket No.: 687-442

Remarks

The Office has withdrawn claims 20-51 and 62-88 from consideration. Applicants reserve the right to file a divisional application related to these claims.

The Office Action rejected claims 1-9, 11-13 and 16 under 35 U.S.C. Section 102(b) as being anticipated by U.S. Pat. No. 4,327,912 to Hoffman. Claims 10, 14-15, 17-19 and 52-61 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Hoffman in view of Copenhaver et al., U.S. Pat. No. 5,720,734.

Applicant respectfully thanks the Examiner for receiving applicant's phone call on February 11, 2003. Applicant appreciates the Examiner's willingness to discuss this case in an effort to expedite prosecution.

Applicant has two informal matters. First, Applicant mailed a Supplemental Information Disclosure Statement in this case on October 27, 2003, but the most recent Final Office Action did not return an initialed copy. Applicant respectfully requests that an initialed copy be returned with the next official action. Second, the power of attorney for the Oppenheimer firm has been revoked. Power of attorney has been granted by the assignee to the undersigned attorney. Applicants request that the next official action be mailed to the undersigned attorney in accordance with the new power of attorney.

With respect to the rejections of claims 1 and 11 based solely on Hoffman, applicant respectfully submits that these original claims are patentable over Hoffman. These arguments are set forth in applicant's previous response and are incorporated by reference herein and are therefore not repeated.

The Examiner suggested that applicant explicitly claim the human body or tissue in combination with the implantable member as a way of defining over the prior art of record. While applicant respectfully thanks the Examiner for the suggestion, applicant believes that it is not necessary to limit the present invention to a combination of an implant and a human body in order to define patentable subject matter. Moreover, applicant does not believe that it should be forced to claim the invention in such narrow terms. Should applicant be forced to claim inventions in the medical device arena in such narrow terms, the basic incentive for seeking medical device related inventions will be adversely affected.

With respect to the rejection of independent claim 52, it is respectfully submitted that this obviousness rejection should be withdrawn.

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Hoffman discloses a game ball such as a tennis ball. The game ball is placed in a canister of a fixed volume at the unclean play site. The canister is then sealed and compacted to a lesser volume. The change in volume subjects the ball to pressure which will impart the desired bounce characteristics. See column 3, lines 7-35 of Hoffman.

Copenhaver et al. does not cure the deficiencies of Hoffman. Copenhaver et al. discloses a gastrotomy port or a one-way entrance seal for medical catheters. These devices operate completely differently than a tennis ball. Catheters are provided in strictly controlled, sterile conditions. Tennis balls are not. One of ordinary skill in the art would not look to gastrotomy ports or medical catheters in order to modify a tennis ball. A combination of these documents against the present invention would be unreasonable and contrary to proper motivation requirements.

Another reason exists to allow claim 52 and its dependent claims. Claim 52 recites a valve stem with a rounded tip. Claim 52 also recites that the piercing has a bend that curves toward the stem side. None of these features are cited in any of Hoffman and Copenhaver et al. Figure 2 of Copenhaver et al. is referenced in the Final Office Action, but this Figure fails to disclose a valve stem with a rounded tip and other limitations. Thus, even if all of the teachings of these references are combined, they fail to teach the present invention as claimed in claim 52.

As a result, it is respectfully submitted that this case is in condition for allowance.

With respect to the restriction requirement, applicants respectfully submit that it is unduly harsh. Should allowable subject matter be identified in response to this amendment, applicants agree to cancel the non-elected claims in order to expedite the grant of a patent.

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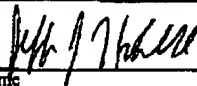
The dependent claims further recite patentable features, but are also allowable in light of their allowable independent claims.

Examination and reconsideration of the application is requested.

If the Examiner comes to believe that a telephone conversation may be useful in addressing any remaining open issues in this case, the Examiner is urged to contact the undersigned attorney at 952-930-6135.

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Date	
February 17, 2004	

Respectfully submitted,

Signature	
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